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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/651,323	08/31/2000	Oscar Lee Avant	08049.0010	3894

22852 7590 10/15/2002

FINNEGAN, HENDERSON, FARABOW, GARRETT &
DUNNER LLP
1300 I STREET, NW
WASHINGTON, DC 20006

EXAMINER

KIM, AHSHIK

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 10/15/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/651,323

Applicant(s)

AVANT ET AL.

Examiner

Ahshik Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07/24/02 (Amendment).
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Amendment

1. Receipt is acknowledged of the amendment filed 24 July 2002. In the amendment, in the
5 claims, the applicant stated "Please cancel claims 1, 18, 26, and 36 follows:", which Examiner
understood as "Please amend claims 1, 18, 26, and 36 follows:". Accordingly, claims 1, 18, 26,
and 36 are amended, and claims 1-36 remain for examination.

Claim Rejections - 35 USC § 102

- 10 The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the
basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- 15 (b) the invention was patented or described in a printed publication in this or a foreign
country or in public use or on sale in this country, more than one year prior to the date of
application for patent in the United States.

2. Claims 1, 7, 10-14, 17, 18, 24, 27-31, and 34-36 are rejected under 35 U.S.C. 102(b) as
being anticipated by Pintsov et al. (US 5,612,889).

- 20 Re claim 1, 17, 18, and 34-36, Pintsov teaches a system and the method for
sorting/processing mail pieces comprising a unique identification code 306 associated with mail
pieces, and generating a file 112, which contains a record for each mail piece (col. 3, lines 31+;
abstract). Since the mailer initiates contact with the carrier over the public network (col. 5, lines
48+), the mailer can make request at any point of the network using proper sign-on process.

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Re claims 7 and 24, Pinstov teaches that when a mailer submits multiple mail items to be processed, each mail pieces is counted and sequentially numbered (col. 10, lines 56+).

Re claims 10, 11, 14, 27, 28, and 31, as shown in figure 4, Pinstov discloses an identification code 306 and matching postal code 402 (col. 11, lines 8 – 17).

5 Re claims 12 and 29, the mailer file 122 contains addresses as an image instead of a text file (col. 8, lines 40+) and also the date 303 when the mailer file was created (col. 10, lines 51+). Although Pinstov shows date instead of time, most of automated mail processing system would use system generated timestamp, which would have date and time of file creation.

Re claims 13 and 30, Pinstov teaches a plurality of error correction code 316, which
10 indicates a status of each record and of a file (col. 10, lines 51+).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

15 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated
20 by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any
25 evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

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invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 2-5, 8, 19-22 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable
5 over Pinstov et al. (US 5,612,899) in view of Ulvr et al. (US 5,602,382). The teachings of Pinstov have been discussed above.

Although Pinstov utilizes a mail piece identifier 306 (col. 10, lines 56+), Pinstov fails to specifically teach or fairly suggest teaching component parts and detailed description of the component parts.

10 Ulvr teaches a mail piece sorting/processing system utilizing a barcode identifying each mail piece. Ulvr further discloses component parts of the code such as start code, class code (or Postal code) and stop code (col. 1, line 66 – col. 2, line 8). The bar code further includes customer information (col. 1, lines 56 – 64) which can include customer address, a date (col. 9, lines 13+) as shown in figure 4b and machine ID (see abstract).

15 In view of Ulvr's teaching, it would have been obvious to an ordinary skill in the art at the time the invention was made to employ well-known Postal code containing various information to the teachings of Pinstov in order to efficiently process each mail piece. For example, there may be an occasion to sort the mail by origin, class or time they were processed etc. etc. Furthermore, storage area (i.e., disk space, tapes, etc.) is relatively inexpensive, and the
20 users can add more information to the code without incurring much cost. Thus, adding more fields for further processing as taught by Ulvr would have been an obvious extension to improve overall productivity of the system.

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4. Claims 6 and 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pinstov et al. (US 5,612,899) in view of Berson et al. (US 6039257). The teachings of Pinstov have been discussed above.

Pinstov fails to specifically teach or fairly suggest that the barcode includes time data.

5 Berson teaches a mail piece sorting/processing system utilizing a barcode identifying each mail piece. The barcode contains identification data and also time-stamp data (col. 2, lines 30+).

In view of Berson's teaching, it would have been obvious to an ordinary skill in the art at the time the invention was made to further incorporate well-known time data to the teachings of Pinstov in order to accurately capture the time the mail piece was processed. Adding time data in addition to date would have been an obvious extension, well within the ordinary skill in the art. Furthermore, when modified address have to be applied to the transmitted file in order to correct the wrong addresses, it is critical to compare exact the time of transmittal and the time modified ed address file was created, and thus an obvious expedient.

15 5. Claims 9 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pinstov et al. (US 5,612,899) in view of in view of Ulvr et al. (US 5,602,382) and Berson et al. (US 6039257). The teachings of Pinstov as modified by Ulvr have been discussed in paragraph 1, and Pinstov as modified by Berson have been discussed in paragraph 2 above. Accordingly, 20 Pinstov as modified by Ulvr and Berson would have all data elements listed in the claim.

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6. Claims 15, 16, 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pinstov et al. (US 5,612,899) in view of Allum et al. (US 5,420,403). The teachings of Pinstov have been discussed above.

Pinstov fails to specifically teach or fairly suggest that the postal code in the file is a

5 POSTNET code.

Allum teaches a mail piece sorting/processing system utilizing a POSTNET code identifying each mail piece (col. 3, lines 53+).

In view of Allum's teaching, it would have been obvious to an ordinary skill in the art at the time the invention was made to employ notoriously old and well-known POSTNET code to the teachings of Pinstov in order to process each mail piece quickly and improve overall throughput of the system. Although conventional barcode or POSTNET code serves the purpose of identifying a mail piece, a POSTNET or modified POSTNET code improves speed of reading/printing such code, and thus an obvious expedient.

15

Response to Arguments

7. Applicant's arguments filed 24 July 2002 have been carefully considered, but they are not persuasive.

With amended claims, Applicant argues that the prior art to Pinstov et al. (US 5,612,889), does not teach an identification code which uniquely identify the mail-piece and identification file that corresponds to the identification code (See amended claims; page 4, 102 (b) rejections on page 4).

20

In response to Applicant's argument, Pinstov's mailing file 120 or mailing identification file 122 contains record for each mail to be processed (col. 10, lines 31+; col. 10, lines 51+), which uniquely identifies each mail-pieces. As discussed during the interview on July 3, 2002, when the mailer submits one mail item to be processed (although it may not occur often), then
5 the file contains only record for the mail piece. When the mailing identification file contains multiple records, the file still is able to uniquely identify each mail pieces.

Applicant perhaps meant to claim one-to-one relationship between the identification code for each mail-piece and the identification file. However, the amended claims do not clearly claim such element. In view of the above, Pinstov's mailing file uniquely identifies each mail
10 pieces.

Applicant further argues that "Pinstov et al., also does not disclose at lease an identification file that may be accessed from a plurality of nodes on the mailpieces sorting system " (Page 5, first paragraph), as shown in figure 9, step 922, Pinstov's embodiment clearly includes mail processing/sorting system (col. 1, lines 18+).

15 In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5
20 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the primary reference to Pinstov et al. and secondary references to Berson et al., Ulvr et al., Allum et al., are directed to a mail processing systems. It is Examiner's view that

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the secondary references disclose what Pinstov et al. lacks. Examiner further believes that adoption of such teaching found in the secondary references are well within the ordinary skill to improve various aspects of the mail processing system.

For the reasons stated above, the Examiner believes that a proper prima-facie case of obviousness has been established. Therefore, the Examiner has made this Office Action final.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (703)305-5203 . The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (703) 305-3503. The fax number directly to the Examiner is (703) 746-4782. The fax phone number for this Group is (703)308-7722, (703)308-7724, or (703)308-7382.

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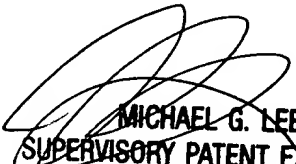
Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

5 *All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.*

10 Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.



15 Ahshik Kim
Patent Examiner
Art Unit 2876
October 3, 2002



MICHAEL G. LEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800